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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/883,996	06/20/2001	Hideto Kihara	1405.1044	2412

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EXAMINER

WON, MICHAEL YOUNG

ART UNIT	PAPER NUMBER
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2155

DATE MAILED: 04/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/883,996

Applicant(s)

KIHARA ET AL.

Examiner

Michael Y. Won

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1, 2, 4-11, 13, and 16 have been amended and new claims 17-19 have been added.

Claim Rejections - 35 USC § 112

2. Rejection based on 35 USC 112, 2nd regarding insufficient antecedent basis has been withdrawn, however claims 1, 2, 9, and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are generally narrative and indefinite, failing to conform to current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

For example, in “correlating conditions relating to a transmission object to said same channel with the processings for said transmission object”, the examiner cannot determine the exact function(s) of this step recited to perform a proper search. As such, the examiner has determined the above to mean: “correlating conditions relating to a transmission object, to said same channel by processing the transmission object”, and has examined the claims accordingly.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-6, 8, and 16-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Moncreiff (US 5,828,839 A).

INDEPENDENT:

As per claims 1, 2, and 16, Moncreiff teaches of a communication assistance method performed by a communication assistance device, a communication assistance device, and a computer-readable recording medium on which is recorded a communication assistance program, used in a communication device capable of simultaneously carrying out two-way communication among a plurality of users sharing the same channel, said communication assistance device and said communication device residing in a user terminal, said method, device, and program comprising: correlating conditions relating to a transmission object to said any same channel with the processings (inherent) for said transmission object (see col.2, lines 8-12 & 38-44; and col.5, lines 31-42) and storing said conditions and processing in a storage means (see col.2, lines 23-26); acquiring from said communication device information relating

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to said channel in accordance with said conditions and said processings (see col.2, lines 40-44); prior to transmission of said transmission object to said channel, determining based on said acquired channel information whether said transmission object meets at least one of said conditions (see Fig.2; Fig.4; and col.4, lines 29-33 & 38-43); conducting at least one of said processings on said transmission object based on said determination results (inherent), and sending said processed transmission object via said communication device to said channel (see Fig.2, #88 and col.5, lines 31-34).

As per claim 19, Moncreiff teaches a communication assistance method, comprising: correlating conditions of an object to be transmitted over a communications medium with processings for the object (see col.2, lines 8-12 & 38-44; and col.5, lines 31-42); and transmitting the object over the communications medium as a processed object if the object meets at least one of the conditions or transmitting the object over the communication medium as an unprocessed object if the object fails to meet any of the conditions (see Fig.2, #56 or #58; and col.4, lines 38-54).

DEPENDENT:

As per claims 3, 17, and 18, Moncreiff teaches of further comprising second storage means storing user-dependent user information which corresponds to said conditions and processings (see col.4, lines 40-43), and registration means accepting input of said user information from a user, and storing the same in said second storage means (see Fig.2, #56; and Fig.5-Fig.7).

As per claim 4, Moncreiff teaches of further comprising second storage means storing user-dependent user information which corresponds to said conditions and processings (see col.4, lines 40-43), and registration means setting said user information based on said channel information, and storing the same in said second storage means (see Fig.2, #56; Fig.5-Fig.7; and col.5, lines 21-30 & 38-42).

As per claim 5, Moncreiff further teaches wherein channel information that said acquisition means acquires from said communication device includes at least information specifying the channel to which said transmission object is to be sent and transmission content (see col.2, lines 38-44).

As per claim 6, Moncreiff further teaches wherein channel information that said acquisition means acquires from said communication device includes at least information specifying the channel to which said transmission object is to be sent and transmission content (see claim 5 rejection above), and when said transmission object meets said condition, said execution means notifies a user of said met condition and transmission content, and depending on the response from the user to said notice, either transmits said transmission or cancels such transmission (see Fig.5).

As per claim 8, Moncreiff teaches of further comprising second storage means storing attributes of a channel with which said communication device is communicating, wherein: said first storage means stores, as a condition, that the channel to which said transmission object is to be sent has an attribute (implicit: see col.1, line 66-col.2, line 12); and said determination means determines whether said condition is met based on

attributes of the channel to which the transmission object is to be sent, said attributes being stored in said second storage means (see rejections above).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 7 and 9-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moncreiff (US 5,828,839 A).

As per claim 7, although Moncreiff teaches of further comprising second storage means (see claim 3 rejection above), and a first storage means stores as a condition that in a channel to which said transmission object is to be sent (see claim 8 rejection above), and said determination means determines, based on whether or not said transmission object meets said condition (see claim 2 rejection above), he does not explicitly teach that second storage stores users classified into classifications, wherein: said first storage means stores as a condition, the number of users belonging to a classification is within a range.

However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The comparing and

determining if the conditions are met would be performed regardless of the conditions.

Thus this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to employ such comparing and determining within the system of Moncreiff by implementing storing as a condition the number of users belonging to a classification is within a range in said first storage and users classified into classification in said second storage within the communication assistance device because such subjective conditions would categorical compare according to the preference of the system designer and result in the same two determination of whether or not to transmit the object. Furthermore the conditions do not functionally relate to the steps of the method claimed.

As per claim 9, Moncreiff teaches of further comprising second storage means correlating the time of the latest message included in said transmission object within said channel with said channel (see abstract, last sentence) and storing this correlated information (inherent). Moncreiff does not teach wherein: said first storage means stores as a condition, that a length of time has elapsed since the latest message was sent into the channel to which said transmission object is to be sent; and said determination means determines whether said transmission object meets said condition based on the time of the latest message in said network to which said transmission object is to be sent (see claim 7 rejection above).

As per claim 10, Moncreiff does not explicitly teach wherein, stored as a condition in said first storage means is, that when a communications address is included in said transmission content, said channel to which said transmission object is to be sent and said communications address belong to different computer channel, and said determination means determines whether said transmission object meets said condition based on the domain name of said communication device and the domain name of the information terminal providing said channel to which said transmission object is to be sent (see claim 7 rejection above).

As per claim 11, Moncreiff does not explicitly teach of comprising second storage means storing a correlation table containing degree of relevance between prescribed words, wherein: stored as a condition in said first storage means is, that the content of transmission object does not match the atmosphere of said channel to which said transmission object is to be sent, and said determination means seeks degree of relevance between earlier communication content and content of said transmission object based on said correlation table, and determines whether said transmission object meets said condition by comparing said sought degree of correlation and a reference value (see claim 7 rejection above).

As per claims 12, Moncreiff does not explicitly teach wherein stored as a condition in said first storage means is, that the usage rate of a language in previous communications is within a certain range, and said determination means determines the usage rate of said language based on identifiers marking the beginning and end of said language (see claim 7 rejection above).

As per claim 13, Moncreiff does not explicitly teach wherein stored as a condition in said first storage means is, that said transmission object contains a word that another user has made a keyword in said channel to which said transmission object is to be sent, and said determination means creates beforehand a list of said keywords based on said acquired channel information, and based on said created keyword list, determines whether or not said keyword is included in said transmission object (see claim 7 rejection above).

As per claim 14, Moncreiff does not explicitly teach wherein stored as a condition in said first storage means is, that said transmission object is not in a format, and said determination means determines whether said transmission object is written in said format or not based on the transmission object acquired from said acquisition means (see claim 7 rejection above).

As per claim 15, Moncreiff does not explicitly teach wherein stored as a condition in said first storage means is, that any portion of a communication in previously transmitted object has been selected, and when said transmission object meets said condition, said execution means adds information indicating that said transmission object is a response to said selected message to said transmission object (see claim 7 rejection above).

NOTE: Moncreiff teaches of a condition and the step of determining that condition. By claiming various different conditions when the functionality remains the same, is not functionally distinct, and does not make the invention novel.

Response to Arguments

5. Applicant's arguments with respect to claims 1-6, 8-10, and 16 have been considered but are moot in view of the new ground(s) of rejection. In view of the amendment, claims 1-6, 8, and 16-19 are rejected based on *Moncreiff* (US 5,828,839 A).

Moncreiff teaches of a condition related to the transmission object (message), and based on the condition (username and password, time zone) present the user with the appropriate web page (chat page). Clearly as referenced in the action above, *Moncreiff* teaches each and every broad limitation claimed.

In response to applicant's arguments, the recitation said communication assistance device and said communication device residing in a user terminal" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Nonetheless, *Moncreiff* teaches of a browser (see col.1, lines 18-22), which clearly teaches this limitation.

No argument has been made of the 103 rejections and therefore, for the reason above, claims 7 and 9-15 remain rejected.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

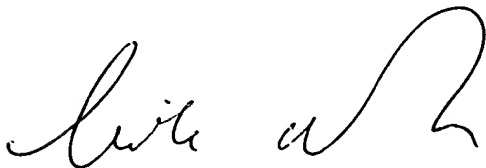
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Y. Won whose telephone number is 571-272-3993. The examiner can normally be reached on M-Th: 7AM-5PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain T. Alam can be reached on 571-272-3978. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Michael Won



April 20, 2005


HOSAIN ALAM
SUPERVISOR, PATENT EXAMINING